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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,671	06/15/2001	Youichirou Sugino	04558/050001	9498

38834 7590 06/03/2004

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EXAMINER

DICUS, TAMRA

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/882,671

Applicant(s)

SUGINO ET AL.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 and 42-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35, 42-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

All prior rejections and objections are withdrawn due to applicant's arguments over Kobayashi not teaching a polarizer.

Claim Objections

1. Claim 42 is objected to because of the following informalities: Line 3 contains "strating" when it should be starting. Also claim 2 appears to lack antecedent basis by referring to "the strating material". Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-18, 21-35, and 42-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,361,838 to Miyatake et al. in view of USPN 6,065,457 to Aminaka.

Miyatake teaches an optical film/member that may be used to produce a multilayer structure by providing optical layers on sides of a polarizing/retardation film that includes absorption types like hydrophilic polymer films of PVA that have been stretched (new limitations). See col. 7, lines 39-65, and col. 8, lines 5-54. Such optical films, like those of instant claims 17 and 29-34 may be used to produce the following types of films: absorption type, reflection type, scattering type polarizers, retardation films including a quarter-wavelength plate, a half-wavelength plate, a retardation film comprising a uni- or biaxially or otherwise

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stretched film, a film comprising a film which has undergone inclined orientation, i.e., which has undergone molecular orientation also in the thickness direction, a film comprising a liquid crystal polymer, a film in which a retardation caused by a viewing angle or birefringence is compensated for, and a film comprising two or more of these retardation films superposed on each other. See col. 8, lines 1-54. Miyatake teaches a polarizing film also includes a polarizing film comprising any of the above-described polarizing films and a transparent protective layer formed on one or each side thereof for the purpose of protection against water. The protective layer may be, for example, a coating layer of a plastic or a laminated film layer. Refer to col. 8, lines 28-30. Miyatake does not explicitly define the aforementioned functional films as "brightness-enhanced" or a "transflector". The Examiner takes the position that the phrase "brightness-enhanced" is a functional equivalent of the optical film of Miyatake at col. 7, lines 38-51 since the optical film that functions to improve perceptibility and bright displays as taught by Miyatake at col. 6, lines 50-60. The Examiner also takes the position that "transflector" is synonymous to an optical layer that reflects or scatters light as taught above in the aforementioned film types. Also note Aminaka teaches liquid crystal displays having ellipsoidal polarizing plates containing optical layers that result in a display exhibiting refractive index and retardation values, which are considered to be a reflector/transflector. Aminaka also teaches a protective layer and adhesive layer may be on a transparent polymer film (also using triacetyl cellulose and hydrophilic polymers). See col. 11, lines 1-33-45, and col. 20, line 30-col. 21, line 35. While Miyatake does not expressly disclose a polarizing plate *per se*, Aminaka teaches the plate above. It would have been obvious to one of ordinary skill in the art to modify the optical film and elements where the films are contained therein of

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Miyatake to include a polarizing plate because Aminaka uses optical layers to form polarizing plates as cited above.

Miyatake does not expressly disclose the shrinkage force requirements of at most 4.0 N/cm of instant claims 1, 8, and 22-23. However, a shrinkage force is merely a measured property of the film. Miyatake and Aminaka already provide the film and thicknesses therefore, any property that is measured and noted therefrom does not make it a new product. Something which is old does not become patentable upon the discovery of a new property. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195.

Miyatake also teaches using an adhesive layer having a thickness of 20 microns of an acrylic PSA in Example 2. Miyatake does not explicitly state the protective or hydrophilic polymer film, or polarizing layer may have thicknesses in the ranges claimed in instant claims 3, 4, 6, 8-11, 24, 25, and 27. However, at col. 5, lines 45-50 Miyatake teaches it is known to provide a thickness to a film anywhere from 1 to 500 microns. As aforesaid, Miyatake teaches protective, hydrophilic polymer films and polarizing layers within the oriented film. Therefore it would have been obvious to one of ordinary skill in the art to modify a film or layer to provide specific thicknesses attributed to any polymeric layer such as a protective, polarizing or hydrophilic polymer layer that is contained within the oriented film since Miyatake teaches the oriented film can be between 1 and 500 microns especially suited for films made by extrusion (changing the die size easily changes the thickness) at col. 5, lines 25-50.

Miyatake does not explicitly state the heat treatment of a polarizer at the process requirements of time and temperature of claims 1, 2, 8, 16, and 21-23, e.g. 70 degree Celsius for

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120 hours of claim 16, the experimental modification of this prior art in order to ascertain optimum operating conditions fails to render Applicant's claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. Further, product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

To amended claims 5, 46 and 47, that the hydrophilic polymer film is a polyvinyl – alcohol film before being stretched does not add any patentable limitation as the compositional make-up of the film is the same before and after any process applied to the film.

Miyatake does not disclose the polymerization and saponification degrees properties of PVA of claims 7 and 28, such properties are inherent since the same material is used. Additionally, Aminaka teaches using PVA having saponification degree of not smaller than 80% and a polymerization degree preferably of not smaller than 200. See col. 20, lines 5-12.

Regards to amended claims 42-45, crosslinking, stressing, stretching, treating, and drying of the film are process limitations in a product claim and are not given any patentable weight.

Response to Arguments

3. Applicant's arguments filed 2-19-04 have been fully considered but they are not persuasive. Applicant alleges the Kobayashi reference does not concern primarily a polarizing

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film, but a protective film applied to a polarizing film. This reference is removed and the new rejection is set forth above. Aminaka is still relied upon to teach the various functionality films e.g. translector, retardation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tamra L. Dicus
Examiner
Art Unit 1774

May 24, 2004



ELIZABETH MULVANEY
PRIMARY EXAMINER